

Applicant: James H. Bennett
Serial No.: 10/052,973
Group Art Unit: 1774

REMARKS

Claims 1-33 have been cancelled and Applicant has added new claims 34-53 with claims 34, 43, and 51 in independent format. It is to be appreciated that current independent claim 34 is substantially similar to independent claims 20 and 27. Therefore, the current rejections are addressed relative to claim 34. There is full support in the specification as originally filed for the new claims. Thus, no new matter has been introduced.

Claims 20-25 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,407,988 to Kogowski. The Examiner contends that the '988 patent discloses granite-looking copolymers molded with colorants through an extruder. Claims 20, and 25-27 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,059,471 to McNally et al. The Examiner contends that the '471 patent discloses a thermoplastic material comprising a colorant. Claims 22-33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the '988 patent in view of the '471 patent, United States Patent No. 6,136,441 to MacGregor et al., and United States Patent No. 5,496,630 to Hawrylko et al.

The '988 patent discloses a thermoplastic product formed by adding fibers to the thermoplastic material prior to extrusion of the thermoplastic product. The resultant thermoplastic product has the fibers **dispersed throughout** the thermoplastic product. The fibers may contain pigments necessary to provide coloration to the product. When the fibers and the thermoplastic are extruded, the fibers are randomly intermixed throughout the product such that there is no control over the location of the fibers throughout the product. Since there is little or no control of the placement of the fibers, the product will have varying physical strength because the fibers are **dispersed throughout** the product. Further, the fibers that are dispersed within the product do not add to the granite-like appearance.

The '471 patent discloses a tile product having a thermoplastic base material. A first adhesive layer is applied to the thermoplastic base material. A plurality of chips is then sprinkled onto the first adhesive layer. A second layer is then applied on top of the

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plurality of chips. The second layer is then cured with the first layer to secure the chips to the first layer and to produce the product.

The subject invention claims a thermoplastic product **consisting essentially of** an extruded thermoplastic layer having a color-containing thermoplastic resin system disposed on the surface of the extruded thermoplastic layer to impart a granite-like appearance to the thermoplastic product. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Claim 34 requires the color-containing thermoplastic resin system include a thermoplastic resin that is **compatible** with the extruded thermoplastic layer. Referring to page 7, lines 16-22 and continuing onto page 8, lines 1-6, “compatibility” refers to the thermoplastic resin being able to substantially bond with, react with, or otherwise adhere to the extruded thermoplastic layer. The compatibility of the thermoplastic resin secures the colorant or the colorant mixture to create the granite-like appearance. Further, the invention as claimed requires that the color-containing thermoplastic resin system be disposed **on the surface** of the thermoplastic layer and the extruded thermoplastic layer or zone is substantially free of the color-containing thermoplastic resin system.

The subject invention, as claimed, is distinguishable from the ‘988 patent. The color-containing thermoplastic resin system of claim 34 is **disposed on the surface** of the extruded thermoplastic layer, whereas the fibers of the ‘988 patent **are dispersed throughout** the thermoplastic layer. By disposing the color-containing thermoplastic resin system on the surface of the extruded thermoplastic layer, the physical properties of the product of the subject invention are determined by the thermoplastic layer. The color-containing thermoplastic resin system does not interfere with the physical properties of the thermoplastic layer. Since the fibers of the ‘988 reference are disposed throughout the product and not necessarily on the surface, the physical properties of the product are not consistent. Therefore, the ‘988 patent does not teach, suggest, or disclose, disposing a color-containing thermoplastic resin system disposed on a surface

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of an extruded thermoplastic layer. The '988 patent does not teach, suggest, or disclose the extruded thermoplastic layer or zone being substantially free of the color-containing thermoplastic resin system

The subject invention, as claimed, is also distinguishable from the '471 patent. Claim 34, as amended, requires the thermoplastic product to **consist essentially of** the extruded thermoplastic layer and the color-containing thermoplastic resin system disposed on the surface of the extruded thermoplastic layer. The color-containing thermoplastic resin system includes colorants and/or colorant mixtures and the thermoplastic resin that is compatible with the extruded thermoplastic layer. The '471 patent, as discussed above, includes a first adhesive layer and a second adhesive layer securing the particles to the thermoplastic product. The inclusion of additional adhesive layers materially affects the novel characteristic of the subject invention. One of the novel characteristics of the subject invention is that the color-containing thermoplastic resin system includes the thermoplastic resin that is compatible with the extruded thermoplastic layer. If the additional adhesive layers were disposed on the extruded thermoplastic layer, then the thermoplastic resin of the color-containing thermoplastic resin system could not interact with the extruded thermoplastic layer. The '471 patent also does not teach, suggest, or disclose the extruded thermoplastic layer or zone being substantially free of the color-containing thermoplastic resin system. Accordingly, each of the 35 U.S.C. §102 rejections are overcome and claims 34-53 are allowable.

Referring to claim 51, the subject invention requires the thermoplastic product to include the extruded thermoplastic layer or zone having the surface and the color-containing thermoplastic resin system be disposed on and **compressed into** the surface of the extruded thermoplastic layer or zone and **bonded to** the extruded thermoplastic layer or zone. The process of forming the thermoplastic product is disclosed and claimed in United States Patent No. 6,372,164. The process includes the steps of extruding at least one thermoplastic in sheet form, providing the color-containing thermoplastic resin system comprising at least one thermoplastic resin that is compatible with the extruded thermoplastic, applying the color-containing system to the extruded thermoplastic, and

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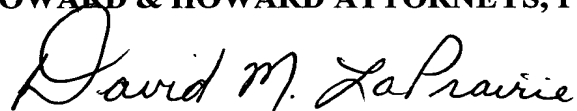
applying a compressive force to the extruded thermoplastic to form the molded thermoplastic product. The subject application, as claimed in claim 51, is directed to the product formed at a moment in time after the compressive force has been applied to the extruded thermoplastic, which is represented in claim 51 by the limitation of the color-containing thermoplastic resin system being **compressed into** and **bonded to** the extruded thermoplastic. None of the cited references disclose, teach, or suggest such a product having the color-containing thermoplastic resin system being “**compressed into said surface**” and “**bonded to said extruded thermoplastic layer**”. Therefore, claim 51 is allowable and claims 52 and 53, which depend from claim 51, are also allowable.

Applicant also believes that the newly added claims overcome each of the Examiner's 35 U.S.C. §103(a) rejections. None of the references, including the '988 patent and the '471 patent, individually or in combination, teach, suggest, or disclose the novel thermoplastic product of the subject invention as claimed.

Accordingly, it is respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. Applicant believes that no fees are due, however, if any become required, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account 08-2789.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.



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Date

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CERTIFICATE OF MAILING

I hereby certify that this Response to Notice of Non-Compliant Amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to **Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450** on November 19, 2003.


Brenda J. Hughes

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